

REMARKS

Claims 1, 3, 7-9 remain in the application.

Applicant acknowledges with appreciation the interview of the instant application with the Examiner on July 27, 2004 and Examiner's helpful comments made at said interview.

I. 35 USC §121 REJECTION

The Examiner has requested under 35 USC §121 for Applicant to select a single disclosed species for prosecution. In order to expedite the prosecution of the instant application, Applicant is acknowledging the selection of mineral oil as the pure oil and silica as the thickener, with traverse. Applicant has amended claim 1 accordingly. Therefore, Applicant respectfully requests that the Examiner withdraw the 35 USC §121 rejection.

II. DOUBLE PATENTING REJECTION

The Examiner has rejected claims 1-9 under the Judicially Created Doctrine of Obviousness-Type Double-Patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,652,748 which is owned by AAF-McQuay Inc., the assignee of the present application.

In response to the double-patenting rejection, Applicant submits herewith a

Terminal Disclaimer to overcome the double-patenting rejection, surrendering patent rights in any patent issuing on the present application past the expiration date of U.S. Patent No. 6,652,748. Therefore, Applicant respectfully requests Examiner to withdraw the double-patenting rejection.

III. 35 USC §112 REJECTIONS

The Examiner has rejected claims 1-9 under 35 USC §112 as being Indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner particularly notes claims 2, 4 and 5 as being Indefinite and that the transitional language in claim 1 is unclear. Applicant respectfully traverses the Examiner on this ground of rejection.

Applicant has amended claim 1 to the inclusion of only the transitional language "comprising" thereby intending this claim to be "open" and has cancelled any reference to the use of other transitional phrases "consisting of" and "including". Claims 2, 4, and 5 have been cancelled. Thus, Applicant urges that remaining claim 1 is no longer Indefinite and respectfully requests that the Examiner withdraw the 35 USC §112 rejection.

IV. 35 USC §103(a) REJECTION

1. The Examiner has rejected claims 1-7 under 35 USC §103(a) as being unpatentable over Perry's Chemical Handbook or Griswold or Lunde in view of Mullin.

and Hamilton. Applicant respectfully traverses the Examiner on this ground of rejection.

The instant invention is now directed to a filter medium for removing particulates from a fluid stream which comprises a porous fiber filter medium and an adhesive coating therefore. The adhesive coating comprises a major portion by weight of mineral oil and a minor portion by weight of a silica thickener.

The Examiner alleges that Perry, Griswold, and Lunde teach the use of mineral oil as an impingement oil coating. However, none of these references teach or remotely suggest the use of a thickener and particularly a silica thickener in combination with a mineral oil on a porous fibrous filter medium.

Moreover, the Mullin reference does not teach the use of a thickener and particularly silica, on a porous fibrous filter medium. Mullin teaches the use of oil plus petroleum wax as the adhesive ingredient and suggests varying the concentration of the wax and oils as a means to adjust the viscosity of the viscous liquid composition for coating air filters.

The Hamilton reference teaches a tri-organic phosphate shell for coating dust filter media. More particularly, Hamilton teaches the combination of a tri-organic phosphate with a pyrogenic silica or a pyrogenic silica and magnesium silicate with an amine to form a gel coating for a dust filter media. Applicant submits that a tri-organic phosphate is not a mineral oil and that an amine is not appropriate for use in the instant claimed composition. Nowhere does Hamilton teach or suggest that the amine can be

eliminated. Thus, there is no suggestion in Hamilton of the use of silica without the inclusion of an amine and a mineral oil as taught by Perry, Griswold, or Lunde as a composition for a porous fibrous filter medium.

Applicant submits that the Examiner is piecemealing the instant invention from the teachings of the prior art using the instant invention as a blueprint, which a long line of patent cases has held to be improper. There is no suggestion in any of these references of combining mineral oil and silica as a coating for a porous fibrous filter medium. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

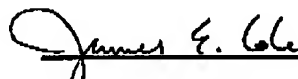
2. The Examiner has rejected claims 8 and 9 under 35 USC §103(a) as being unpatentable over Perry or Griswold or Lunde in view of Mullin and Hamilton and further in view of Wrightson. Applicant respectfully traverses the Examiner on this ground of rejection.

Claims 8 and 9 are dependent claims of independent claim 1, as amended. That is, claims 8 and 9 include all of the limitations of claim 1. Wrightson is cited as merely teaching a filter frame that snaps together, allegedly the limitations of dependant claims 8 and 9. Wrightson does not correct the deficiencies of the unique chemical composition of a mineral oil and silica for coating a porous fiber filter medium. Thus, Applicant urges that since Wrightson does not correct the deficiencies in the teachings of the references in the rejection of independent claim 1, the instant invention, as now

claimed, is patentably distinct over the combination cited by the Examiner. Therefore, Applicant respectfully requests that the Examiner withdraw this rejection.

Applicant urges that with the amendments to the claims, the instant application is now in condition for allowance. However, if the Examiner believes there are other issues in this case, Applicant's attorney of record would appreciate a call at (502) 584-1135 to discuss such remaining issues.

Respectfully submitted,

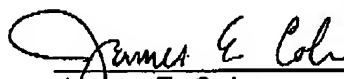


James E. Cole
MIDDLETON REUTLINGER
2500 Brown & Williamson Tower
Louisville, Kentucky 40202
(502) 584-1135
Reg. No. 50,530

The statutory disclaimer fee required by 37 C.F.R. § 1.20(d) of \$110.00 is submitted herewith.

Respectfully submitted,

Date: 8/30/04


James E. Cole
Reg. No. 50,530